Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BRIAN S. MUEHL

Appeal No. 2001-2011
Application No. 08/402,413

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and SCHEINER, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 3, the only claims remaining in the application.

We refer to Appendix A, which accompanied appellant's brief, for the claims on appeal (as amended by the amendment after final filed December 17, 1996).

The references relied on by the examiner are:

Descamps et al. (Descamps '707)	3,920,707	Nov. 18, 1975
Descamps et al. (Descamps '204)	4,007,204	Feb. 8, 1977
Pestellini et al. (Pestellini)	4,485,112	Nov. 27, 1984
Kennedy et al. (Kennedy)	WO 89/02893	Apr. 6, 1989

All of the claims stand rejected under 35 U.S.C. § 103 as unpatentable over Kennedy, Descamps '707, Descamps '204 and Pestellini.[1]

DISCUSSION

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[1] The examiner has withdrawn two previous rejections of the claims under 35 U.S.C. § 112 and the doctrine of obviousness-type double patenting (Answer, page 7).

Claims 1 through 3 are drawn to "benzothiophene compounds substituted at the 6-position, with a bridging group at the 3-position, and having a basic side chain." Brief, page 3. In view of its brevity, we reproduce the examiner's rejection in its entirety (except that, for the sake of clarity, we have substituted a single name for a reference wherever the examiner has used more than one name for the same reference):

> Kennedy [ ], Descamps ['204, Descamps '707] and Pestellini are references in the same field of anti-angina/anti-arrhythmia compounds. Kennedy [d]isclosed compounds having a protected hydroxy or alkoxymethylene chain between the benzothi[o]nyl moiety and the phenyl moiety. The combined teachings of Descamps '204, [Descamps] '707 and Pestellini [ ] placed the following teaching in the possession of the artisan that:
>
> 1) the benzofuranyl ring system and benzothi[o]nyl ring system are interchangeable for such compounds (see [Descamps] '204 vs [Descamps] '707:
>
> 2) the linkage between the bicyclic ring system and the phenyl ring can be CO or substituted alkylene (see [Descamps] '204 v [Kennedy], linkage at 3-position, see [Kennedy] p. 7 formula XV, XVI and p. 9 formula XX.
>
> 3) the position isomers also have the expected similar activity (see Pestellini);
>
> 4) the substituents on the linking alkylene chain can be hydroxy, alkoxy, acylated hydroxy, amino, mono- or di-alkylamino (see [Pestellini's] linking group);
>
> 5) the "other substituent on the bicyclic ring system can be alkyl, cyclohexyl, or phenyl[.]

Answer, pages 4 and 5.

Noticeably missing from this disjointed series of conclusions is a coherent

statement explaining why any of the claims on appeal are unpatentable.[2] We are at a loss as to exactly how and why the examiner proposes combining the references to arrive at the claimed compounds. For that matter, the examiner's rejection does not even identify how the claimed compounds correspond to or differ from the prior art.[3]

On cursory review of the Kennedy reference, however, we note that Kennedy's compound XXI, although unsubstituted at the 6-position, appears to be particularly close to the claimed compounds in all other respects - provided certain selections are made for R_3, R_5 and R_6 (we leave it to the examiner to determine whether this is actually the closest compound described). Indeed, appellant, at least, seems to indicate that Kennedy teaches "benzothiophene compounds" which differ from the claimed compounds only in that they "are not substituted at the 6-position." Brief, page 5.

It may be that somewhere in the references cited by the examiner there is a reason or suggestion to substitute Kennedy's compounds at the 6-position in the manner claimed. If so, the examiner has not identified it. As set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

> Most if not all inventions arise from a combination of old elements. [] Thus, every element of a claimed invention may often be found in the prior art. [] However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed

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[2] As stated in Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996) (citation omitted), "It is well-established that before a conclusion of obviousness may be made based upon a combination of references, there must have been a reason, suggestion or motivation to lead an inventor to combine those references."

[3] In the future, the examiner would be advised to set forth an obviousness rejection structured according to the model set forth in MPEP 706.02(j). This will ensure that the rejection includes a discussion of why one of ordinary skill in the art would have had reason to make the proposed modifications to the prior art.

> invention. [] Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted]

What is lacking in the examiner's treatment of the claims on appeal is a reason, suggestion or motivation, stemming from the prior art, which would have led a person having ordinary skill to the claimed method. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). On this record, the only reason or suggestion to modify the references to arrive at the present invention comes from appellants' specification, and we are constrained to reverse the examiner's rejection of claims 1 through 3 under 35 U.S.C. § 103.

REVERSED

Sherman D. Winters Administrative Patent Judge	)
	) BOARD OF PATENT
William F. Smith Administrative Patent Judge	) APPEALS AND
	) INTERFERENCES
Toni R. Scheiner Administrative Patent Judge	)

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